



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,161	03/09/2004	John Fred Davis	END920030160US1	3025
26502	7590	12/10/2008	EXAMINER	
IBM CORPORATION IPLAW SHCB/40-3 1701 NORTH STREET ENDICOTT, NY 13760			JAKOVAC, RYAN J	
			ART UNIT	PAPER NUMBER
			2445	
			MAIL DATE	DELIVERY MODE
			12/10/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/796,161	<b>Applicant(s)</b> DAVIS ET AL.	
	<b>Examiner</b> RYAN J. JAKOVAC	<b>Art Unit</b> 2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/04/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16, and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0177120 to Kirsch in view of Spamhaus.

Regarding claim 1, 9, 21, The combination of Kirsch and Spamhaus teaches a method of blocking unwanted e-mails, said method comprising the steps of:

Determining that e-mail is unwanted (Kirsch, paragraph [0025], unwanted email messages are identified.);

determining a source IP address of said unwanted e-mail (Kirsch, paragraph [0036], IP address determined. See also, fig. 3.).

Spamhaus discloses determining a registrant of said IP address of said unwanted e-mail and querying an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant of the source IP address of said unwanted e-mail.

Art Unit: 2445

(Spamhaus, The Spamhaus Block List ("SBL") collates information identifying the owners or registrants of IP addresses or domains which are known to send spam (i.e. unwanted e-mail). The Spamhaus Block List is a list of IP addresses compiled by the same team that maintains the ROKSO database, broadcast in realtime to independent DNS-based 'Blocklist' systems. All IPs on the SBL belong to known spammers, spam gangs, or spam support services. The SBL includes IPs from both the ROKSO database and IPs of spam services listed in the Spamhaus database.).

Kirsch does disclose and in response, blocking subsequent e-mails from said other IP addresses (Kirsch, paragraph [0025], unwanted emails are blocked.).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to combine determining other source IP addresses owned or registered by an owner or registrant of the source IP address of said unwanted e-mail as taught by Spamhaus with the method of Kirsch in order to be able to refuse email from known spammers (Spamhaus, The Spamhaus Block List ("SBL") can be used by most modern Mail Servers to refuse email from known spammers and spam support services.).

Regarding claim 2, 10, 22, The combination of Kirsch and Spamhaus teaches a method as set forth in claim 1 further comprising the step of blocking subsequent e-mails from said source IP address of said unwanted email (Kirsch, paragraph [0025], unwanted emails are blocked.). wherein the step of determining other source IP addresses owned or registered by an owner or registrant of the source IP address of said unwanted e-mail comprises the step of determining an

Art Unit: 2445

owner or registrant of said source IP address of said unwanted e-mail (Spamhaus, SBL listings list known spammers and their associated IP addresses.).

Regarding claim 3, 11, 23, The combination of Kirsch and Spamhaus teaches a method as set forth in claim 2 wherein the step of determining said registrant of the source IP address of said unwanted e-mail is performed by querying an entity that manages registration of IP addresses (Kirsch, fig. 2, examination of whitelist and blacklist.).

Regarding claim 4, 12, 24, The combination of Kirsch and Spamhaus teaches a method as set forth in claim 1 wherein said entity is Internet Assigned Number Authority (Spamhaus, The SBL includes IPs from both the ROKSO database and IPs of spam services listed in the Spamhaus database.).

Regarding claim 5, 13, 25, The combination of Kirsch and Spamhaus teaches a method as set forth in claim 1 wherein the step of determining that an e-mail is unwanted comprises the step of identifying an e-mail which is attempted to be sent to multiple recipients and the same or substantially the same text (Kirsch, paragraph [0003], emails filtered by words that appear in the message. See also paragraph [0025], [0032], and fig. 4a and 4b.).

Regarding claim 6, 14, 26, The combination of Kirsch and Spamhaus teaches a method as set forth in claim 1 wherein the step of determining an e-mail is unwanted comprises the step of

Art Unit: 2445

identifying an e-mail which is attempted to be sent to multiple recipients and contains the same or substantially the same subject line (Kirsch, paragraph [0003], emails filtered by subject line.).

Regarding claim 7, 15, 27, The combination of Kirsch and Spamhaus teaches a method as set forth in claim 1 wherein the step of determining a source IP address of the unwanted e-mail comprises the step of reading the source IP address from a header of the unwanted e-mail (Kirsch, paragraph [0003], IP address from header used to filter message.).

Regarding claim 8, 16, 28, The combination of Kirsch and Spamhaus teaches a method as set forth in claim 2 wherein the steps of blocking e-mails from said source IP address and blocking subsequent e-mails from said other IP addresses comprises the step of identifying said e-mails from said source IP address and said other IP addresses at a firewall or router, and then preventing them from passing through to a mail server(s) for their intended recipients (Kirsch, paragraph [0025], unwanted emails are blocked.).

### ***Response to Arguments***

3. Applicant's arguments filed 08/04/2008 have been fully considered but they are not persuasive.

4. The examiner notes that the cited Spamhaus reference was retrieved from The Internet Archive Wayback Machine at <http://www.archive.org> which is an online archive of internet web sites. The Internet Archive Wayback Machine is a service that allows people to visit archived versions of Web sites. Visitors to the Wayback Machine can type in a URL, select a date range,

and then begin surfing on an archived version of the website. The Spamhaus reference has been archived and dated December 11, 2001.

5. The Spamhaus Block List (SBL) includes IPs from both the ROKSO database and IP's of spam services listed in the Spamhaus database. The Register of Known Spam Operations (ROKSO) database collates information and evidence on known professional spam operations that have been terminated by a minimum of 3 Internet Service Providers for spam offenses. As evidenced in the cited art, the SBL lists the owners or registrants of the IP addresses or domains from which spam is sent. See Spamhaus, pg. 2, which shows the internet domain cpuguys.com, the IP addresses used by the domain to send spam (i.e. 63.116.175.9 – 63.116.175.255) and the registration details for the domain (i.e. CPU Guys Inc, 309 Main Street, Hanson, MA, 02341). Therefore, Spamhaus discloses determining a registrant of said IP address (i.e. CPU Guys Inc.) of said unwanted e-mail and querying an entity that manages registration of IP addresses to determine other source IP addresses registered to said registrant (i.e. range of IP addresses used) of the source IP address of said unwanted e-mail.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It would have been obvious to one of ordinary skill in the art at the time of invention to combine Kirsch with Spamhaus since Spamhaus gathers the registrant and IP information of known spammers (as evidenced by the Spamhaus Blocklist Advisory as cited) and Kirsch seeks to block known spammers (as

evidenced by at least the “blacklist” identifying senders of spam as referenced in at least [0013-0014], [0027-0030], and fig. 2).

### ***Conclusion***

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. JAKOVAC whose telephone number is (571)270-5003. The examiner can normally be reached on Monday through Friday, 7:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2445

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RJ/

/Larry D Donaghue/  
Primary Examiner, Art Unit 2454